REMARKS

The present application was filed on September 23, 2003 with claims 1-20. Claims 1-20 are currently pending in the application. Claims 1 and 17-20 are the independent claims.

In the Office Action, claims 1-5, 8, 10-12 and 15-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2002/0060995 (hereinafter "Cervello") in view of U.S. Publication No. 2004/0203889 (hereinafter "Karaoguz"). In addition, claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Cervello in view of Karaoguz in further view of U.S. Publication No. 2004/0203698. Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over Cervello in view of Karaoguz in further view of U.S. Publication No. 2003/0017858. Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over Cervello in view of Karaoguz in further view of allegedly well known prior art. Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over Cervello in view of Karaoguz in further view of U.S. Publication No. 2004/0052232. Finally, claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over Cervello in view of Karaoguz in further view of U.S. Patent No. 6,813,501.

Applicants respectfully traverse these rejections and request reconsideration of the claims in light of the following remarks.

With respect to the §103(a) rejections, Applicants note that for a valid §103(a) rejection, the reference or reference combination must teach or suggest all the claim limitations. Manual of Patent Examining Procedure, Eighth Edition, August 2001, §2143. Moreover, a *prima facie* case of obviousness can only be established if there is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Id. Any such showing of obviousness "must be based on objective evidence of record" rather than "subjective belief and unknown authority." In re Sang-Su Lee, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430 (Fed. Cir. 2002).

Claim 1 sets forth:

A method for use in a wireless network comprising a plurality of user devices adapted for communication with at least one access point device, the method comprising the steps of:

initiating a test of a communication link between at least one of the user devices and the access point device, the test comprising a determination of data throughput performance; and

generating, based at least in part on a result of the test, an instruction displayable to a user associated with a given one of the user devices, the instruction being indicative of a location at which the given user device is expected to obtain a particular level of data throughput performance.

In formulating the §103(a) rejection of this claim, the Examiner argues that each and every limitation included therein is taught or suggested by the combination of Cervello and Karaoguz. More particularly, with respect to the limitation of the claim beginning with "initating a test," the Examiner states on pp. 2-3 of the Office Action:

Referring to claim 1, Cervello discloses a method for use in a wireless network comprising a plurality of user devices adapted for communication with at least one access point device (Figs. 1-2 Abstract and paragraph 9, "system for dynamically selecting a communication link"), the method comprising the steps of initiating a test of a communication link between at least one of the user devices and the access point device (Figs. 1-2, Abstract, and paragraphs 0008-0010, "determining whether a new channel to be used by the plurality of wireless station is needed", "received signal strength indication (RSSI)").

Cervello does not specifically disclose **the test comprising a determination of data throughput performance, and generating, based at least in part on a result of the test, an instruction displayable to a user associated with a given one of the user devices, the instruction being indicative of a location at which the given user device is expected to obtain a particular level of data throughput performance.**

Karaoguz discloses a method of determining optimal cell configuration based upon determined device location, which teaches **a test comprising a determination of data throughput performance** (page 4, paragraphs 41-44, "device makes its evaluation and assessment of what is or are optimal location(s)", "corresponding optimal locations along with the corresponding data rates", "additional information . . . data capabilities information such as data rate", note that test (evaluation and assessment) is initiated so that optimal locations are determined. Further note that data throughput performance (data rate) information is provided with corresponding optimal locations, hence it is inherent that the test comprises a determination of data throughput performance) . . . .

Applicants respectfully disagree. Karaoguz at paragraph 0038 states:

3

Following the determination of the location information of the user's wireless device, the configuration device can determine the communication capacity of the user's wireless device at step 310. In other words, the configuration device can determine the communication capacity such as the data type capacity and the data rate capacity of the user's wireless device. The data type capacity can inform the configuration device about the types of data the user's wireless device can manage. For instance, the data type capacity can inform the configuration device whether the user's wireless device can manage audio, video and/or text, etc. Similarly, the data rate capacity can inform the configuration device about the data rates the user's wireless device can achieve. The communication capacity information corresponding to the user's wireless device can be embedded in the request message or can be embedded in a separate message signal from the wireless device to the configuration device. Furthermore, the communication capacity information can be preprogrammed within a look-up table or a storage unit in the configuration device, and can be accessed by an identifier of the wireless device. (*Emphasis added*).

As a result, Karaoguz does not, as the Examiner argues, teach or suggest "a test comprising a determination of data throughput performance," nor is this determination somehow inherent the reference. Rather, the data rate of a user's wireless device in Karaoguz is either embedded in a message sent by the wireless device or determined by reference to a lookup table or storage device. Not test of data rate is utilized.

Karaoguz, therefore, fails to teach or suggest all the limitations in claim 1. What is more, in stating the motivation for combining aspects of Karaoguz with Cervello, the Examiner states on p. 4 of the Office Action:

> It would have been obvious to one of the ordinary skill in the art at the time of the invention to modify the method of Cervello by allowing the test to comprise a determination of data throughput performance, and providing generating [*sic*], based at least in part on a result of the test, an instruction displayable to a user associated with a given one of the user devices, the instruction being indicative of a location at which the given user device is expected to obtain a particular level of data throughput performance, as suggested by Karaoguz, motivation being for the purpose of providing the best available signal strength for the user, and consequently making wireless users happy.

Clearly, in contravention to the requirements for a valid §103(a) rejection stated above, the above-quoted argument lacks any basis in objective evidence of record that would motivate one skilled in the art to combine the references as suggested. Instead, the Examiner has apparently used

4

improper hindsight by using the Applicant's teachings as a blueprint to hunt through the prior art for the claimed elements and combine them as claimed. The result is an argument to combine references that finds its motivation in advantageous aspects of the present invention. The Federal Circuit has repeatedly held that such an approach is "an illogical and inappropriate process by which to determine patentability." Sensonic, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

Applicants believe that independent claims 17-20 are in condition for allowance for reasons similar to those recited above for independent claim 1.

Dependent claims 2-5, 8, 10-12, 15 and 16 are also believed to be in condition for allowance for at least the same reasons as independent claim 1. Moreover, many of these claims are believed to comprise separately patentable subject matter. For example, dependent claim 10 sets forth:

> The method of claim 1 wherein the test comprises a test sequence involving the transmission of a plurality of known packets at different bit rates between the at least one user device and the access point device.

In formulating the §103(a) rejection, the Examiner argues that this claim is taught or suggested by Cervello in the description of a "packet error rate" in the Abstract and paragraphs 008, 009 and 0036 (Office Action, p. 6). Applicants respectfully disagree and submit that the determination of a packet error rate in Cervello is never described to require the transmission of a plurality of known packets at different bit rates.

With respect to the §103(a) rejections of dependent claims 6, 7, 9, 13 and 14 over Cervello in view of Karaoguz in further view of other references, Applicants submit that the other references fail to correct the fundamental deficiencies of the Cervello-Karaoguz combination with respect to independent claim 1.

5

In view of the above, Applicants believe that claims 1-20 are in condition for allowance and respectfully request the withdrawal of the §103(a) rejections.

A Notice of Appeal is submitted concurrently with these remarks.

Respectfully submitted,

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Joseph B. Ryan
Attorney for Applicant(s)
Reg. No. 37,922
Ryan, Mason & Lewis, LLP
90 Forest Avenue
Locust Valley, NY 11560
(516) 759-7517